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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,495	07/02/2003	Tienteh Chen	200209928-1	4418

22879 7590 03/14/2007
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EXAMINER	
SCHWARTZ, PAMELA R	
ART UNIT	PAPER NUMBER

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/613,495	CHEN ET AL.	
	Examiner	Art Unit	
	Pamela R. Schwartz	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 January 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4,6,7,9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 9, 11-20 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,6 and 7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20060403.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

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1. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admissions in their 131 Declaration. The papers filed by applicants admit that both the base paper and the ink receptive coating of their invention were known at the time of their invention. Based upon this admission, it would have been obvious to one of ordinary skill in the art to coat the commercially available base paper with a known ink receptive composition at a conventional coating weight in order to obtain an ink receptive medium.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Dagan et al. (6,291,127). The reference discloses that imaging members having base members with Sheffield smoothness and porosity within the instantly claimed ranges are known in the art. See Table 1. The reference discloses ink receiving layers ranging from 3 to 75 microns in thickness. In order to clarify the rejection with respect to the coating weight, the thickness range set forth by the reference is considered to inherently produce overlap with the coating weight range recited by applicants based upon the breadth of the prior art range and the materials contained within the prior art coating material.

Applicants may overcome this rejection by demonstrating that the values for layer thickness recited by the reference would not result in a coating weight range that overlaps with that of the instant claims. It is noted that coating weight in g/m² and

coating thickness are related and a conversion may be made between the two using the density of the dry coating as a conversion factor. The ink receiving layer may contain polyvinyl alcohol, modified silica particles, surfactants, cross-linking agents and mordant (col. 12, line 58 col. 13, line 13 and lines 46-57).

3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagan et al. (6,291,127) as relied upon above and further in view of Shih et al. (6,780,924) and Koike et al. (6,777,039) for reasons of record and for reasons given below.

4. Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagan et al. (6,291,127) as relied upon above and further in view of Nigam et al. (6,936,316) for reasons of record and for reasons given below.

5. Applicant's arguments filed January 12, 2007 have been fully considered but they are not persuasive. With respect to Sheffield Porosity and Smoothness, Table 1 does include values within the ranges instantly claimed. See Example 5. Control examples are part of the disclosure of the reference. With respect to the motivation for combining a known ink jet receptive coating with a known base paper is that such a coating composition requires a substrate in order to be used for its intended function. The base paper has also been disclosed as known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to coat an ink receptive coating composition on a known base paper so that it can perform its intended function. Such a combination of base paper and ink receptive coating would have been obvious to one of ordinary skill in the art in the absence of an unexpected synergistic result.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
March 12, 2007



PAMELA R. SCHWARTZ
PRIMARY EXAMINER